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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,784	11/07/2001	Michiko Fukuda	15056	7912

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GARDEN CITY, NY 11530

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,784

Applicant(s)

FUKUDA, MICHIKO

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements filed 11/7/2002, 8/20/2002 and 7/7/2003 (papers no. 7, 8 and 11) have been considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Matsubara et al. (US PAT. 5,345,258 hereinafter Matsubara).

Regarding claim 1, Kadowaki discloses a telephone unit as shown in figure 4 having a telephone directory with picture data comprising video interface (10, figure 3) for receiving compressed image data from a distant station (col. 3 lines 34-35), decoding means (20) for

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decoding the received compressed image data into an image signal (col. 3 lines 31-32), correlating means (50, figure 3) for correlating the image signal with a telephone number of the distant station (col. 4 lines 4-6), and registering means (41, figure 1) for registering the image signal and the telephone number with the telephone directory (col. 4 line 48 through col. 6 line 17). Kadowaki differs from the claimed invention in not specifically teaching receiving compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register. However, Matsubara teaches a videophone capable of storing received video data, i.e., compressed moving picture data in a storing means using a relatively small amount of storage comprising decoding means (18B, figure 3) for decoding the receiving video signal and encoding means (22B, figure 3) for encoding video signal decoded by the decoding means into a compressed still picture data for storage (col. 4 lines 1-34 and col. 6 lines 13-33). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Kadowaki in capable of receiving compressed moving picture data from the distance party, wherein the telephone unit includes first decode means for decodes the compressed moving picture data and encoding means for encoding one or more frames of the decoded moving picture data into compressed still picture data in order to register, as per teaching of Matsubara, because it can store video signal using a relatively small amount of storage.

Regarding claim 2, Kadowaki discloses to correlate the compressed still picture data with personal information of the distant station, wherein the personal information includes the telephone number of the distant station (col. 4 lines 60-64).

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Regarding claim 5, Matsubara discloses a first display means (20B, figure 3) for displaying the decoded moving picture and selecting means (23B, figure 3) for selecting one or more frames to be encoded by the encoding means (22B, figure 3) in response to an operation by a user (col. 4 lines 1-46 and col. 6 lines 13-33).

Regarding claim 6, Kadowaki discloses second display means as shown in figure 2 for displaying the decoded still image data decoded by decoding means (col. 6 lines 15-34 and col. 5 line 9-38).

Regarding claim 7, Kadowaki teaches to display the decoded still picture when originating a call to the distant station (col. 5 lines 9-23).

Regarding claim 8, Matsubara teaches to display the decoded still picture when terminating a call from the remote station (col. 6 lines 40-58).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 7.

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Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 8.

5. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Matsubara et al. (US PAT. 5,345,258 hereinafter Matsubara) as applied in claims above, and further in view of Kimura et al. (US PAT. 5,778,054 hereinafter Kimura).

Regarding claim 3, the combination of Kadowaki and Matsubara differs from the claimed invention in not specifically teaching to register the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file. However, Kimura teaches a storage device storing access information, i.e., telephone numbers, corresponding to image information, wherein the access information and the image information are registered in JPEG format so that it recognizes the access information being recorded in a comment segment of a JPEG file in order to simplify physical structure and intuitive graphical user interface (col. 4 line 29 through col. 6 line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Kadowaki and Matsubara in registering the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file, as per teaching of Kimura, because it simplifies physical structure and intuitive graphical user interface.

Regarding claims 4 and 11-12, the limitations of the claims are rejected as the same reasons set forth in claim 3.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu (US PAT. 5,907,604) discloses an image icon associated with caller ID (abstract). Gotoh et al. (US PAT. 5,396,269) discloses a television telephone having a telephone directory function (col. 20 line 16 through col. 21 line 44). Ogawa (JP 05153286) discloses a video telephone system for correlating or storing a telephone and an image corresponding to the telephone number (abstract).

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng

Examiner

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